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ROSSI, KIMMS & McDOWELL LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147			MEJIA, ANTHONY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/755,032	IKENO, HIDEO	
	Examiner	Art Unit	
	ANTHONY MEJIA	2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 February 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 4-8, 12-16 and 18 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 9-11, 17 and 19-22 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>02/27/2009</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Japanese Application No. 2003-005155, filed on 10 January 2003.

Response to Amendment

2. It is hereby acknowledged that Claims 1, 4, 9, 12, and 17-21 have been currently amended. Claims 4-8, 12-16, and 18 remain withdrawn from consideration as a result of an earlier restriction requirement (see Office Action dated: 25 November 2008). The applicants are reminded that a complete response to this **FINAL** Office Action should cancel the withdrawn Claims. As a result, Claims 1-3, 9-11, 17, and 19-22 are currently pending in the instant application.

3. Amendment to Claims 1, 4, 9, and 12 in response to examiner's rejection under 35 U.S.C. 112 2nd has been considered. The amendment obviates the previously raised rejection, as such this rejection hereby withdrawn.

Response to Arguments

4. Regarding the rejections of Claims 1-2, 9-10, 17, and 19-22 under 35 U.S.C. 102(e) as being anticipated by Turnbull (US 7,146,412) and Claims 3 and 11 as being unpatentable over Turnbull in view of Loughran (US 2002/0129107),

Applicant's arguments filed **25 February 2009** have been fully considered but they are not persuasive. Therefore, the rejections are maintained.

At pages 10-11 of the Remarks, Applicants attempt to distinguish the claimed invention from the prior art by arguing that Turnbull and Loughran individually and/or in combination fail to disclose the step of: **upgrading a program or firmware through an email** (emphasis added). Specifically, Applicant argues that Turnbull **upgrades the system via a network rather than an email** and Loughran discloses **an upgrade server that sends an SMS message containing instructions for connecting a mobile device to the upgrade server to download the upgrade software** (emphasis added).

As to the arguments above, the Examiner respectfully disagrees. It is noted by the Examiner that the Applicants failed to patentably distinguish upgrading the system via a network or an upgrade server as taught by the teachings of Turnbull and Loughran from the Claims. There is nothing in the claim that would further specify as to what constitutes the step of: **upgrading a program or firmware through an email** (emphasis added). As currently claimed, the alleged step of: upgrading a program or firmware through an email is broad enough to be interpreted as: upgrading the system via a network and/or upgrading a system through an upgrade server that sends an SMS message containing instructions for connecting a mobile device to the upgrade server to download the upgraded software as taught by Turnbull and Loughran. Thus applicants are encouraged to amend the claim by further defining the structure in a way that would distinguish the claimed invention from the applied references.

In any case, in alternative embodiment, Turnbull clearly teaches the step of: **upgrading a program or firmware through an email** (e.g., in a no-cost upgrade, the selectable upgrade option is configured to initiate a second applet **embedded in the email that will automatically download and install the upgrade onto computing device 102 without further user input**, col.5, lines 39-42, and col.7, lines 30-33) (emphasis added).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 9-11, 17, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Turnbull (US 7,146,412).

Regarding Claim 1, Turnbull teaches a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored and

communicating with a management apparatus (server 110) (col.4, lines 55-58, col.5, lines 61-67, and col.6, lines 1-2), the monitoring apparatus comprising:

an e-mail unit (e-mail application program) configured to carry out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

a processing unit (CPU 336) configured to be operable when said e-mail unit has received second modules for updating first modules (current firmware), on which the monitoring apparatus operates, from the management apparatus by e-mail, to automatically update the first modules in operation to the second modules (upgraded firmware) (col.5, lines 36-51, and col.7, lines 30-33 and lines 62-67);

an information unit (upgrade applet 318) configured to collect version information on the first modules when said unit has received a version information acquisition request from the management apparatus by e-mail (col.7, lines 62-67, and col.8, lines 10-13); and

a returning unit (e-mail application program) configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.5, lines 28-36, col.7, lines 62-67, and col.8, lines 31-38 and 54-64).

Regarding Claim 2, Turnbull teaches a monitoring apparatus according to claim 1, further comprising:

a receiving unit (applet 318) configured to receive an update instruction e-mail containing at least the second modules and an install script (col.7, lines 30-33 and lines 62-67), and an acquisition request e-mail requesting acquisition of the version information indicative of versions of respective ones of the first modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13),

wherein said processing unit (CPU 336) is configured to activate the install script contained in the update instruction e-mail received by said receiving unit (col.7, lines 30-34, and col.7, lines 60-67), and to update the first modules in operation to the second modules contained in the update instruction e-mail received by said receiving unit, and said information collecting unit is configured to collect the version information in response to the acquisition request e-mail received by said receiving unit (col..8, lines 10-13), and said returning unit is configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.8, lines 31-38, and 54-64).

Regarding Claim 9, Turnbull teaches a control method executed by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.4, lines 55-58, col.5, lines 61-67, and col.6, lines 1-2), the method comprising:

a communication step of carrying out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

a processing step of automatically updating first modules (current firmware), on which the monitoring apparatus operates, in operation to second modules (upgraded firmware) for updating the first modules when the second modules is received from the management apparatus by e-mail in said communication step (col.5, lines 36-51, col.7, lines 30-34 and 62-67 and col.8, lines 58-60);

an information collecting step of collecting version information on the first modules when a version information acquisition request is received from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

a returning step of sending the version information collected in said information collecting step to the management apparatus by return mail (col.5, lines 28-36, col.7, lines 62-67, col.8, lines 31-38, and lines 54-64).

Regarding Claim 10, Turnbull teaches a control method according to claim 9 as discussed above. Turnbull further teaches wherein the method further comprises:

a receiving step of receiving an update instruction e-mail containing at least the second modules and an install script, and an acquisition request e-mail requesting acquisition of the version information indicative of versions of

respective ones of the modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13);

wherein said processing step comprises activating the install script contained in the update instruction e-mail received in said receiving step, and updating the first modules in operation to the second modules contained in the update instruction e-mail received in said receiving step, and said information collecting step comprises collecting the version information in response to the acquisition request e-mail received in said receiving step, and said returning step comprises sending the version information collected in said information collecting step to the management apparatus by return e-mail (col.5, lines 39-42, col.7, lines 30-33, and col.8, lines 31-38, and lines 54-64).

Regarding Claim 17, Turnbull teaches a computer-readable medium storing a computer program for executing a control method implemented by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.6, lines 12-17, and lines 39-56), the method comprising:

a communication step of carrying out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

a processing step of automatically updating first modules (current firmware) on which the monitoring apparatus operates, in operation to second modules for updating the first modules when the second modules (upgraded

firmware) for updating the modules is received from the management apparatus by e-mail in said communication step (col.5, lines 36-51, col.7, lines 30-34 and lines 62-67, and col.8, lines 58-60);

an information collecting step of collecting version information on the first modules when a version information acquisition request is received from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

a returning step of sending the version information collected in said information collecting step to the management apparatus by return mail (col.5, lines 28-36, col.7, lines 62-67, and col.8, lines 31-38 and lines 54-64).

Regarding Claim 19, a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored and communicating with a management apparatus (server 110) (col.5, lines 61-67, and col.6, lines 1-2), the monitoring apparatus comprising:

an e-mail unit configured to carry out communication with the management apparatus by email (col.5, lines 28-36 and col.7, lines 62-67);

a processing unit configured to be operable when said e-mail unit has received an update instruction e-mail containing at least second modules for updating first modules, on which the monitoring apparatus operates, and an install script from the management apparatus, to automatically update the first

modules in operation to the second modules corresponding to description of the install script (col.5, lines 36-51, col.7, lines 30-33 and lines 62-67);

an information collecting unit configured to collect version information on the first modules when said e-mail unit has received an acquisition request e-mail that requests acquisition of the version information on the first modules from the management apparatus by e-mail (col.7, lines 62-67 and col.8, lines 10-13); and

a returning unit configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.5, lines 28-36, col.7, lines 62-67, col.8, lines 31-38, and lines 54-64),

wherein the install script includes at least one or more commands which are executable in an operating system including said processing unit in the monitoring apparatus (col.7, lines 30-34, and lines 63-67).

Regarding Claim 20, a monitoring apparatus according to claim 19, wherein the acquisition request e-mail requests acquisition of the version information indicative of versions of respective ones of the first modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13).

Regarding Claim 21, Turnbull teaches a control method executed by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device

102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.5, lines 61-67, and col.6, lines 1-2), the method comprising:

a communication step of carrying out communication with the management apparatus by email (col.5, lines 28-36 and col.7, lines 62-67);

a processing step of automatically updating first modules, on which the monitoring apparatus operates, in operation to second modules corresponding to description of the install script when an update instruction e-mail containing at least second modules for updating first modules and an install script are received from the management apparatus in said communication step (col.5, lines 36-51, col.7, lines 30-34 and line 62-67, and col.8, lines 58-60);

an information collecting step of collecting version information on the first modules when an acquisition request e-mail that requests acquisition of the version information on the first modules from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

a returning step of sending the version information collected in said information collecting step to the management apparatus by return e-mail (col.5, lines 28-36, col.8, lines 31-38, and lines 54-64),

wherein the install script includes at least one or more commands which are executable in an operating system including said processing step in the monitoring apparatus (col.7, lines 30-34, and lines 63-67).

Regarding Claim 22, Turnbull teaches a control method according to claim 21 as discussed above. Turnbull further teaches wherein the acquisition request

e-mail requests acquisition of the version information indicative of versions of respective ones of the first modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull in further view of Loughran et al (US 2002/0129107) (referred herein after as Loughran).

Regarding Claim 3, Turnbull teaches a monitoring apparatus according to claim 1 as discussed above. Turnbull does not explicitly teach wherein the monitoring apparatus further comprises a decoding unit configured to decode contents of an e-mail received by said e-mail unit, and wherein said unit is configured to interpret an instruction from the management apparatus from the contents of the received e-mail decoded by said decoding unit, and to perform processing according to the interpreted contents of the e-mail.

However, Loughran in a similar field of endeavor discloses a method and apparatus for automatic content handling including wherein the monitoring

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apparatus (email server 10) further comprises a decoding unit (email server 10) configured to decode contents of an e-mail received by said e-mail unit, and wherein said unit is configured to interpret an instruction from the management apparatus from the contents of the received e-mail decoded by said decoding unit, and to perform processing according to the interpreted contents of the e-mail (pars [0009], [0025-0026], [0037], and [0046]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Turnbull with the teachings of Loughran in order to automatically interpret the contents of an e-mail without user intervention. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Turnbull and Loughran to help make upgrades more accessible and require less effort from the users of the apparatuses (Turnbull: col.1, lines 65-67, and col.2, lines 1-53)

Regarding Claim 11, this control method claim comprises limitation(s) substantially the same, as those discussed on claim 3 above, same rationale of rejection is applicable.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Examiner has cited particular paragraphs, columns, and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY MEJIA whose telephone number is (571)270-3630. The examiner can normally be reached on Mon-Thur 9:30AM-8:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A.M./
Patent Examiner, Art Unit 2451

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